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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/922,473 | 08/03/2001 | Alex Ulrich | 155696-0033 | 7208 |

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EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,473

Applicant(s)

URICH, ALEX

Examiner

Michael M. Thompson

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 16, 18-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 16, 18-22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5, 16, 20, and 22, are rejected under 35 U.S.C. 102(b) as being anticipated by Saaski et al. (5,585,011). Saaski et al. teaches an input tube, a filter housing with filter, an input, and a flow restrictor wherein the filter is into the filter housing with diameters of applicant's invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 16, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley ('271) in view of Saaski et al. ('011). Easley teaches all of the limitations of the claims except for explicitly reciting a flow restrictor that has a diameter between 0.1 to 1 millimeters. Saaski et al. teaches a flow restrictor that has a diameter between 0.1 to 1 millimeters. It would have been obvious to one of ordinary skill in the art, at the time of

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invention to modify the device taught by Easley to incorporate flow restriction diameters as taught by Saaski et al. for the purpose of maintaining proper flow restriction within the surgical field of ophthalmology in the prevention of damage to the eye during a medical procedure.

Furthermore, in the event that Applicant disagrees with the modification of Easley, Applicant should note that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claims 3-4, 18-19, 21, 24, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Easley in view of Saaski et al. as applied to claims 1, 5, 16, 20, and 22 above, and further in view of Beuchat. Easley and Saaski et al. both teach all of the limitations of the claims except for explicitly reciting luer fittings on the input and output tubing. Beuchat teaches luer type fittings for tubing. It would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the combination of Easley and Saaski et al. with luer type fittings for connecting any tubing of the aspiration device for the well know purpose of providing a versatile method connectivity and allowing for the user to change portions of the device if they become defective or used.

6. Claims 3-4, 18-19, 21, 24, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Saaski et al. in view of Beuchat. Saaski et al. teaches all of the limitations of the claims except for explicitly reciting luer fittings on the input and output tubing. Beuchat teaches luer type fittings for tubing. It would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the device as taught by Saaski et al. with luer type fittings for connecting any tubing of the aspiration device for the well know purpose of providing a versatile

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method connectivity and allowing for the user to change portions of the device if they become defective or used.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 3-5, 16, 18-22, and 24-25 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.


Contacts

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Thompson whose telephone number is (571) 272-4968. The Examiner can normally be reached on Monday through Friday from 9 am to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Nick Lucchesi, can be reached on (571) 272-4977. The official fax phone number for all submissions to the organization where this application or proceeding is assigned is (703) 872-9306.

Michael M. Thompson

Patent Examiner


NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
ART UNIT 3763

MT 

April 30, 2005